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Banner & Witcoff Ltd 1001 G Street N W Washington, DC 20001-4597			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/479,918	KLATT ET AL.
	Examiner Ella Colbert	Art Unit 3624

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

1. Claims 1-32 are pending in this communication filed 09/29/03 entered as Response, paper no. 10.
2. The Supplemental IDS filed 10/24/03 has been reviewed and entered as paper no. 8.
3. The Extension of Time filed 09/29/03 has been entered as paper no. 9.
4. Applicants' Letter Under 37 C.F.R. 2001.06 (b) Regarding Related Applications is hereby acknowledged.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
6. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik.

With respect to claim 1, Yaksich teaches, (1) monitoring the sales management system to detect a predefined sales event (col. 2, lines 4-67); (2) in response to detecting the predefined sales event in step (1), generating event data comprising information that describes the sales event (col. 1, 49-67, col. 2, lines 1-67). Yaksich did not teach, (3) in a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product

should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data.

Sevcik discloses, (3) in a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a print processing facility for receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data and to modify in Yaksich in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

With respect to claim 2, Yaksich did not teach, wherein step (3) comprises the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is produced.

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Sevcik discloses, wherein step (3) comprises the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is produced (col. 5, lines 21-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of automatically generating a procurement request that requires approval by a corporate employee; and further comprising the step of approving the procurement request before the printed product is produced and to modify in Yaksich because such a modification would allow Yaksich to understand the significance of receiving an immediate quote computed from various print providers, to consider the process involved, the transaction costs to the organization, and the steps that are apart of the process before the printed product is produced.

With respect to claim 3, Yaksich teaches, transmitting the procurement request to a procurement system located at a corporate facility (col. 8, lines 28-34, col. 9, line 1 to col. 11, line 39).

With respect to claim 4, Yaksich teaches, further comprising the step of transmitting the approval to the print processing facility which, in response thereto, produces the printed product (col. 39, lines 39-42).

With respect to claim 5, Yaksich teaches, wherein the print order comprises a print production request that is directly fulfilled by a print production system without further approvals (col. 40, lines 65-67 and col. 41, lines 1-17).

With respect to claim 6, Yaksich did not teach, further comprising the step of checking one or more print criteria that must be satisfied before the printed product is actually produced.

Sevcik discloses, further comprising the step of checking one or more print criteria that must be satisfied before the printed product is actually produced (col. 6, lines 27-67 and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step for checking one or more print criteria that must be satisfied before the printed product is actually produced and to modify in Yaksich because such a modification would allow Yaksich for the customer (buyer) to have the capability to look at several print options and types of variables prior to the printed product being produced.

With respect to claim 7, Yaksich did not teach, wherein the printed product comprises sales literature.

Sevcik discloses, the printed product comprises sales literature (col. 7, lines 3-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the printed product comprise sales literature and to modify in Yaksich because such a modification would allow Yaksich to have what is known as marketing collateral which includes sales and data sheets and brochures (sales literature).

With respect to claim 8, Yaksich and Sevcik did not teach, wherein the printed product comprises an award for a sales employee, but it would have been obvious to one having ordinary skill in the art at the time the invention was made for the printed

product to comprise an award for a sales employee and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have a different design option and for the user to have the capability to print the specifications of the design (see col. 8, lines 59-64 –Sevcik).

With respect to claim 9, Yaksich did not teach, further comprising the step of transmitting over the Internet the event data to the print processing facility.

Sevcik discloses, the step of transmitting over the Internet the event data to the print processing facility (col. 3, lines 21-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit over the Internet the event data to the print processing facility and to modify in Yaksich because such a modification would allow Yaksich to have an automated Internet system that features a series of graphical interfaces which represent various printed products that are linked to a database of prices and other variable option from various print providers and to have the optimal equipment for the project to be computed and for the project to be produced on the most efficient equipment for that particular product.

With respect to claim 10, Yaksich did not teach, further comprising the step of retrieving corporate specific information in addition to the event data and using the corporate-specific information to generate a print production request. Sevcik discloses, retrieving corporate specific information in addition to the event data and using the corporate-specific information to generate a print production request (col. 3, lines 41-67 and col. 4, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to retrieve corporate specific information in addition

to the event data and use the corporate-specific information to generate a print production request and to modify in Yaksich because such a modification would allow Yaksich to have a system that has a complex database of information for custom products which allows for search and retrieval of specific information and automatically generates quotes for custom products and ensures the project is produced on the equipment for that particular product

With respect to claim 11, Yaksich and Sevcik did not teach, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate database, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have corporate-specific information comprises a corporate logo that is not stored in the corporate database and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have the information that is entered to become part of the database for that item (the item could be a corporate logo).

With respect to claim 12, Yaksich did not teach, wherein step (3) comprises the step of generating a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility. Sevcik discloses, generating a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility (col. 9, lines 26-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate a print production request to produce the printed product without

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any human intervention at the corporate facility and without any human intervention at the print production facility and to modify in Yaksich because such a modification would allow Yaksich to have a system have a home page that includes all of the information that a print buyer needs in order to send a print production job over the Internet from a corporate facility to a print production facility.

With respect to claim 13, Yaksich teaches, further comprising the step of translating at least some of the event data into a common print production request based on a schema mapping between fields in the corporate database and fields stored in the print processing facility (col. 11, lines 30-39 and col. 13, line 1 to col. 16, line 55).

With respect to claim 14, Yaksich teaches, (4) monitoring a second corporate sales management system to a second predefined sales event different from the predefined sales event of step (1) (col. 5, lines 30-46); (5) in response to detecting the second predefined sales event in step (4), generating second event data comprising information that describes the second predefined sales event (col. 6, lines 58-67 and col. 7, lines 1-9); and (6) in the print processing facility, receiving the second event data, comparing the second event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a second print order for the printed product using information extracted from the second event data (col. 7, lines 10-64).

With respect to claim 15, Yaksich teaches, wherein the predefined sales event comprises adding a new client to a client list (fig. 16-customer ID and Job ID#) (customer list with new client added at the bottom of the list).

With respect to claim 16, Yaksich teaches, further comprising the step of creating the one or more event rules by specifying parameters on a computer screen (col. 12, lines 20-34 and col. 14, lines 50-57).

With respect to claim 17, Yaksich teaches, a computer-implemented database monitor located at a corporate facility, wherein the database monitor detects changes to the corporate sales management system and, in response thereto, generates event data comprising information that describes the sales management event (col. 5, lines 30-61). Yaksich did not teach, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data. Sevcik discloses, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a print processing facility, located at a geographic location

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different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data and to modify in Yaksich in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

This claim is also rejected for the similar rationale given above for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given above for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given above for claims 3 and 4.

With respect to 20, this dependent claim is rejected for the similar rationale given above for claim 4.

With respect to 21, this dependent claim is rejected for the similar rationale given above for claim 5.

With respect to claim 22, Yaksich teaches, wherein the print order comprises one or more print criteria that must be satisfied before the printed product is actually produced (col. 9 and 10, lines 25-67 and col. 11, lines 1-15).

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With respect to claim 23, Yaksich and Sevcik did not teach, wherein the print processing facility notifies a corporate employee via e-mail of the print order, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the print processing facility notify a corporate employee via e-mail of the print order and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have the capability to have the delivery service send the image to the client for approval and the client can contact the system by electronic mail to confirm approval of the order (notification of the print order to the client (employee) via e-mail).

With respect to claim 24, Yaksich and Sevcik did not teach, wherein the corporate employee is specified in one of the predefined event rules, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the corporate employee specified in one of the predefined event rules and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have a confirmation from the client (corporate employee) as to the approval to execute the order in full according to the description in the client's order (predefined event rules).

With respect to claim 25, this dependent claim is rejected for the similar rationale given above for claim 9.

With respect to claim 26, this dependent claim is rejected for the similar rationale given above for claim 10.

With respect to claim 27, this dependent claim is rejected for the similar rationale given above for claim 11.

With respect to claim 28, this dependent claim is rejected for the similar rationale given above for claim 12.

With respect to claim 29, this dependent claim is rejected for the similar rationale given above for claim 13.

With respect to claim 30, this dependent claim is rejected for the similar rationale given above for claim 7.

With respect to claim 31, Yaksich teaches, a print processing facility coupled to a plurality of corporate locations each comprising a sales management system, wherein the print processing facility receives from each of the plurality of corporate locations event data describing a predefined sales, compares the event data to one or more predefined event rules that determine whether a printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 49-67, col. 2, lines 1-67, and col. 3, lines 1-29).

This independent claim is rejected for the similar rationale given above for claim 1.

With respect to claim 32, this dependent claim is rejected for the similar rationale given above for claim 15.

Response to Arguments

7. Applicants' arguments filed 09/29/03 have been fully considered but they are not persuasive.

The following appear to be the Applicants' main issues:

Issue no. 1: Yaksich does not teach either the "monitoring" or the "generating" elements of claim 1 as asserted by the Examiner and further, Yaksich, does no "monitoring" of a "sales system to detect a predefined sales events" therefore, Yaksich does not teach or suggest a "sales system" has been considered but is not deemed persuasive based on the Examiner interprets Yaksich as teaching monitoring the sales management system to detect a sales event in col. 1, lines 63-67 ("...the same form may be printed at a number of geographically remote locations on different typed of printers, the forms can be distributed and updated automatically ... an order for the form may be transmitted to a vendor's (seller's) manufacturing facility or facilities ... for production and distribution. The CLF (Central Library Facility) is typically located at a centralized facility of the forms consumer (customer), while the FAP is typically located at a centralized facility of the vendor (forms manufacturer-seller) ..." and col. 2, lines 1-3 ("... typically a PC, is located at end user sites to communicate with the CLF and receive distributed forms therefrom.") and 14-67 ("... communication with other print facilities (e.g. a manufacturer of business forms, and internal print shop, or the like)" and "generating event data comprising data that describes a sales event" in col. 1, lines 49-67 and col. 2, lines 1-67 and Sevcik discloses a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that

determine whether the printed product should be produced and, ..." in col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2.

Issue no. 2: Yaksich does not teach or suggest any detection of a "predefined sales event" and no detection of the occurrence of a sales event is described, nor is generation of any "event data comprising information that describes the sales event" has been considered but is not deemed persuasive because Yaksich discusses the printing facilities (such as More Business Forms, Inc.) deliver printed forms as indicated by line to use locations ..., while the traditional plant supplies paper forms to use locations through a warehouse run by the forms manufacturer, ...". These forms have to be produced, printed and sold to customers from the warehouse of distribution site. Thus, a sales event takes place with a description of the sales event.

Issue no. 3: Sevcik does not teach a "printing processing facility" and thus no "receiving" etc. can take place there within has been considered but is not deemed persuasive based on Yaksich discusses a printing processing facility and Sevcik discusses the sale of print products.

Issue no. 4: Applicants' respectfully submit that the Office Action does not establish a *prima facie* case of obviousness has been considered but is not deemed persuasive based on the following case law: A suggestion/ motivation need not be expressly stated in one or all of the references used to show obviousness. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); *In re Sheckler*, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971). It is assumed that every reference relies to some extent on the knowledge of persons

skilled in the art to complement that which is disclosed therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

Issue no. 5: Additionally, similar to claim 1, the office action fails to establish a *prima facie* case of obviousness, for among other things there is no suggestion or motivation to combine has been considered but is not deemed persuasive the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner interprets Yaksich as

teaching monitoring the sales management system to detect a sales event in col. 1, lines 63-67 ("...the same form may be printed at a number of geographically remote locations on different typed of printers, the forms can be distributed and updated automatically ... an order for the form may be transmitted to a vendor's (seller's) manufacturing facility or facilities ... for production and distribution. The CLF (Central Library Facility) is typically located at a centralized facility of the forms consumer (customer), while the FAP is typically located at a centralized facility of the vendor (forms manufacturer-seller) ..." and col. 2, lines 1-3 ("... typically a PC, is located at end user sites to communicate with the CLF and receive distributed forms therefrom.") and 14-67 ("... communication with other print facilities (e.g. a manufacturer of business forms, and internal print shop, or the like)" and "generating event data comprising data that describes a sales event" in col. 1, lines 49-67 and col. 2, lines 1-67 and Sevcik discloses a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, ..." in col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2. Thus, Yaksich and Sevcik are considered combinable.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


E. Colbert
January 14, 2003



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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